

Remarks

Claims 24-44 are pending prior to entry of this Amendment. By way of this Amendment, claims 24, 28, 39, 40, 42, and, 44 have been amended, and claims 41 and 43 have been canceled. No new matter has been added.

Pending rejections are addressed in turn below.

Rejection under 35 USC 112, First Paragraph

Claims 24, 25, 28-32, and 39-41 stand rejected under 35 USC 112, first paragraph as non-enabled for the solvate form recited in the claims. In order to further prosecution, claims 24, 28, and 39 have been amended to remove the recitation of "solvate". As such, the recitation of solvate is no longer present in the pending claims, and Applicants submit that the rejection under 35 USC 112, first paragraph with regard to the solvate recitation has been overcome. Applicants note that removal of "solvate" does not exclude solvates from the scope of the claims in circumstances in which the claimed compounds and compositions might be embodied in solvate form.

Claims 39-44 stand rejected under 35 USC 112, first paragraph as non-enabled for the full scope of the claims. The Office acknowledges activity of the claimed compound on the CB2 receptor but challenges the correlation between the disclosed assay and treatment of the various conditions recited in claims 39-44. To further prosecution, Applicants have narrowed claims 39, 40, 42, and 44 (canceled claims 41 and 43) to specify specific methods of treating pain and inflammation as identified on page 17 of the specification. Applicants have provided scientific literature in the corresponding information disclosure statement as evidence of what would be known to one of ordinary skill in the art. Applicants submit that the literature provides scientific basis (enablement) for treatment of the recited conditions based on the demonstrated activity of the claimed compound on the CB-2 receptor. As such, claims 39, 40, 42, and 44 have been shown to be enabled and the rejection under 35 USC 112, first paragraph with regard to the enablement rejection has been overcome.

Double Patenting

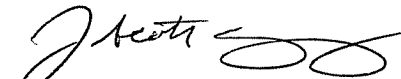
Claims 24-44 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting over pending claims of copending application No. 10/597,527. Whereas this is a provisional double patenting rejection, and the cited application has not yet been patented, Applicants respectfully request that the provisional double patenting rejection be held in abeyance so that prosecution of the instant case may proceed.

Conclusion

Applicants assert that the instant Amendment places the application in a condition for allowance, and such allowance is respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge any fees or credit any overpayment, particularly including any fees required under 37 CFR Sect 1.16 or 1.17, and any necessary extension of time fees, to deposit Account No. 07-1392. The Examiner is invited to contact the undersigned at (919) 483-8160, to discuss this case, if desired.

Respectfully submitted,



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